Remarks

Claims 1 to 20 are pending. The cancellation of claims 9-12 and 15-18 is without prejudice to a divisional application containing such claims. The cancellation of claims 19 and 20 renders the need to discuss the rejection of those claims under 35 USC 112 moot.

Claims 1-8, 13, 14, 19, and 20 stand rejected under 35 USC § 103(a) as being unpatentable over either the translation of DE –452, or WO –857, each taken in view of Wyeth et al. or Schrenk et al. This rejection is traversed.

Attached to this amendment is a table comparing elements of the application claims with the disclosures of the references cited against the claims. The undersigned attorney has studied the references, and if a listed element of the present claims was found in a reference, it has been noted by its location in the reference table. A blank space in the table corresponding to a claim element indicates that no disclosure of that claim element was found in the reference. The table is a convenient summary of the differences between the pending claims and the references. The abbreviated descriptions of the claim elements are for purposes of convenient presentation and do not change the actual claim language or scope.

Also attached is a Rule 132 Declaration by one of the inventors, Richard A. Kollaja, to which reference will be made hereinafter. This Declaration is submitted to: provide a record copy of the photograph shown to the Examiner during the July 7, 2004, interview; and to address certain points raised by the Examiner pertinent to the disclosure of German Patent Publication 19806452.

The Examiner has stated the rejection is substantially for the reasons set forth in paragraph 12 of Paper No. 040604 (Office Action of April 13, 2004), together with additional observations in the current Office Action.

In paragraph 12 of the prior Office Action, the Examiner said, "both of the primary references disclose, in certain embodiments, polymeric co-extruded multilayer webs which are made from a variety of thermoplastic and other conventional polymers which can include adhesives and the like, and can be arranged in a wide variety of laminated embodiments such as those applicants claim." Actually, of the two primary references, only WO '857 discloses a multilayer web having at least two discontinuous layers comprising a plurality of distinct phases continuous down-web, at least three layers which are continuous down-web and cross-web, the phases being

embedded between continuous layers and separated from each other by continuous layer material. The fact that WO '857 does not disclose pressure-sensitive adhesive (PSA) was addressed in Applicants' Response dated July 8, 2004 (pages 6-7), and the Response dated March 6, 2004 (page 7).

In the current Office Action (page 3), the Examiner has said that Applicants have in essence, "ignored the Examiner's position that the various prior art combinations clearly disclose, in certain embodiments, almost any polymeric co-extruded multilayer web made from a variety of continuous and/or discontinuous thermoplastic and other conventional polymers that can include adhesive layers and the like." Applicants have not ignored the Examiner's position. They have traversed it and have shown the claim elements which are missing from the cited art for which there is no explanation provided under the criteria of a *prima facie* obviousness rejection.

The only place on the record in which the Examiner has attempted to explain the obviousness of PSAs is at page 4 of the current Office Action at which he has stated, "DE –452 at page 3, next to last paragraph clearly teaches the utilization of styrene based adhesive layers in a wide variety of embodiments, of which it is believed that pressure sensitive adhesives would clearly constitute a member thereof." This is an unsupported assertion by the Examiner which is specifically traversed. He has provided no evidence that styrene based adhesives would be PSAs. The attached Rule 132 Declaration by Mr. Kollaja establishes that the styrene-based copolymers disclosed in DE '452 would not be PSAs.

As shown by the attached 132 Declaration, the styrene-based copolymers of DE '452 are not PSAs, nor are they adhesives. DE '452 (page 3) says that the SBS and SEBS copolymers which it uses are particularly well suited as thermoplastic elastomers (TPE) since "styrene copolymers are used in many cases as an adhesion promoter or as an adhesive, and will, thereby, assure a good adhesion to most of the thermoplastic polymers employed". The reference does not say that the styrene based TPEs that it uses are themselves adhesives, but simply that they will adhere well to the thermoplastic polymers employed in the coextruded film of the DE '452 invention.

Therefore, the obviousness of using PSAs as continuous layers in the claimed co-extruded films has not been established.

The Examiner's assertion in his Office Action dated April 13, 2004 (sentence bridging pages 5 and 6 which dismisses claim 6 and unspecified dependent claims as conventional), has

been specifically traversed (last Response, page 7). There has been no showing by the Examiner of the claim limitations in the rejected dependent claims (and claim 6) as being disclosed in the cited prior art. As the attached comparison table shows, the prior art does not disclose continuous co-extruded layers made of foamed PSA (rejected claim 6); the acrylic PSAs of claim 4; or the Markush groups of polymers in claim 8.

Page 6 of the Office Action of April 13, 2004, states, "Note again the secondary references and their teachings with respect to the state and skill of the art which clearly indicate that a particular co-extruded web structure involving a desired number of layers, each layer being either continuous or discontinuous in a desired direction and which may further utilize a plurality of distinct phases are each believed to be parameters that are well within the ordinary skill of the art." This assertion is specifically traversed, and has already been discussed in Applicants' Responses of July 8, 2004 (pages 7-8), and March 6, 2004 (pages 7-8). Neither secondary reference discloses a multilayer web having at least two discontinuous layers comprising a plurality of distinct phases that are continuous down-web and at least three layers continuous down-web and cross-web wherein the discontinuous phases are embedded between continuous layers and separated from each other by continuous layer material. The assertion that any particular co-extruded web structure containing a plurality of distinct phases is well within the ordinary skill of the art is simply not substantiated by the references.

The very next sentence of the Office Action of April 13, 2004, states that both Wyeth and Schrenk (the secondary references), "are relied upon only to show that thermoplastic materials such as applicants contemplate can be made from a variety of layers and can be formed with a variety of fluid passageways . . .." The reliance on specific passages in Wyeth and Schrenk has been discussed and traversed in Applicants' Response of July 8, 2004 (pages 7-8), and the Examiner has not responded to Applicants showing that Wyeth's ridges, grooves, etc., are not the same as the claimed discontinuous layers, and that the part of Schrenk to which the Examiner has referred relates to Schrenk Figures 9 and 10 showing a rod or filament having a laminated configuration (which bears no relation to the presently claimed multilayer webs).

At page 7 of the Office Action of April 13, 2004, the Examiner has relied upon DE '452, page 5, lines 4-7. In the current Office Action, he has continued to rely on DE '452, but has failed to respond to the point made in Applicants' Response of July 8, 2004, page 8, in which it is pointed

out that DE '452 distinguishes itself from multilayer films. The whole point of DE '452 is to make a single layer of co-extruded film which is different from multilayer co-extruded films. It states that the multilayer films are isotropic (page 2, third paragraph, and at page 5, second full paragraph). The film described as inventive in DE '452 is a single layer having side-by-side parallel strips of TPE and thermoplastic, resulting in a film which is elastic cross-web and plastic down-web. There would be no reason for a skilled person to utilize DE '452 in combination with a patent (such as WO '857) on multilayer co-extruded films.

In order to arrive at the rejected claims from the teachings of the references cited, one would have to modify the references as follows:

1. to have claim 1, specify that at least one continuous layer is PSA;
2. to have claim 4, specify continuous layers of acrylic PSA;
3. to have claim 6, make continuous layers of foamed PSA;
4. make continuous layers from the blends of polyolefins and elastomeric block copolymers specified in claim 8;
5. combine the continuous layer blends just mentioned with discontinuous layer material selected from the Markush group of claim 8; and
6. as to claim 14, make multilayer films having two continuous layers between each discontinuous layer.

The references do not teach any of the above modifications. The differences between the claims and the cited art are significant and they have not been substantively addressed in the Office Actions. The above listed modifications are too great and too numerous to be obvious to one of ordinary skill. Only hindsight, with the benefit of the knowledge of the present invention, would make such modifications possible. Hindsight reconstruction of claims is an impermissible basis for an obviousness rejection, In re Bond, 15USPQ2d 1566, 1568-69 (Fed. Cir. 1990) and W.L. Gore Assoc., Inc. v. Garlock, Inc., 721F.2d, 1540, 220USPQ 303 (Fed. Cir. 1983), *Cert. Denied*, 105S.Ct.172 (1984).

A *prima facie* case of obviousness has not been established by the Examiner. A *prima facie* case requires that the prior art references teach or suggest all claim limitations. That has not been shown with regard to the above-recited claim limitations. A *prima facie* case also requires that there must be a suggestion or motivation, either in the references themselves or in the knowledge

generally available to one of ordinary skill, to modify the references or combine the reference teachings, Ecolochem Inc. v. Southern California Edison Co., 56USPQ2d 1065, 1075-1076 (Fed. Cir. 2000). There must also be a reasonable expectation of success in achieving the invention of the claims rejected. The Examiner has not established that there is any suggestion or motivation in the references or the ordinary skill of the art to make the modifications required. He has not shown that such suggestion or motivation exists with a reasonable expectation of success in making the invention claimed in this application. The USPTO cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth a rationale which adequately addresses the issue of motivation to select the references and combine them as the Examiner has done, In re Lee, 61USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

In view of the above discussion, it is respectfully submitted that claims 1-8, 13, and 14 are in condition for allowance. Withdrawal of the rejections under 35 U.S.C. 112 and 103 are requested and a notification of allowability is respectfully solicited. If any issues or questions remain the resolution of which the Examiner feels would be advanced by a conference with Applicants' attorney, he is invited to contact such attorney at the telephone number noted below.

Respectfully submitted,

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S.N. 10/028,638	WO 92/12857 Schrenk	DE 19806452 A1	US 3,982,877 Wyeth	US 3,759,647 Schrenk
Claim 1, ≥2 discontinuous layers each layer comprising plurality of distinct phases that are continuous down-web	Abstract, Fig. 3, p. 6, ll. 26-31, p. 13, ll. 20-30, p. 14, ll. 21-24, p. 32, ll. 34-35			
≥3 layers continuous down-web & cross-web	Figs. 3 & 4		Col. 4, ll. 4-10	Col. 8, ll. 40-52
phases are embedded between continuous layers and	Figs. 3 & 4, p. 7, ll. 1-21, p. 10, ll. 11-22			
are separated from each other by continuous layer material	Fig. 3, p. 6, ll. 26-31, p. 10, ll. 11-15, p. 13, ll. 20-33, p. 14, ll. 21-32			
≥1 continuous layer is pressure sensitive adhesive				Col. 8, ll. 53-57
Claim 4 Continuous layers are acrylic pressure sensitive adhesive and				
discontinuous phases comprise non-pressure sensitive adhesive, thermoplastic polyolefin, etc.	p. 25, ll 8-9, 16			
Claim 6 continuous layers are foamed pressure sensitive adhesive				
Claim 8 continuous layers = Markush group blends of polyolefins and elastomers and				
discontinous layers comprise Markush group cyclic polyolefins, etc.				
Claim 14 2 continuous layers between each discontinuous layer				